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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,723	08/06/2001	James M. Holden	M-9131 US	1115

34036 7590 03/16/2004

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EXAMINER

MERLINO, AMANDA H

ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/923,723

**Applicant(s)**

HOLDEN, JAMES M.

**Examiner**

Amanda H Merlino

**Art Unit**

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-10 is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11,12 and 15-17 and 20-27 is/are rejected.
- 7) ☒ Claim(s) 2,3,13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-8, 11, 12, and 15-17 and 20-27 rejected under 35 U.S.C. 103(a) as being unpatentable over Seaburn (6,084,662).

Seaburn et al teach of measuring characteristics of a sample (2) comprising a light source (6) for emitting light towards a sample (6), a reflective element (1) within said optical path and downstream of said sample (6) and a light detector for receiving reflected light.

Seaburn lacks the teaching of a sample support and a means of positioning the sample support.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to utilize a sample support since it would be obvious that the sample would not be not be "floating in air" but would be held by some kind of support system.

Furthermore, in reference to the "means for positioning", one would have to manually place the sample support in a position for detection of light to occur. Examiner believes that the claims in the present state allow for the above rejections, since the lacking elements in the prior art reference of Seaburn are somewhat inherent parts of the apparatus.

With regards to claims 4 and 11, Official Notice is taken that the use of optical elements such as lenses and apertures to change the position of light beams are old and well known in the art. See In Re Malcolm 1942C.D.589:543 O.G.440.

***Allowable Subject Matter***

Claims 9-10 allowed.

Claims 2-3 and 13-14 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 2-3, and 9-10, the prior of record, taken alone or in combination, fails to disclose or render obvious an apparatus for measuring characteristic of a sample comprising an actuator for moving the sample support or the reflective element upstream and downstream in the optical path, in combination with the rest of the limitations of claims 1 and 9 respectively.

As to claims 13-14 the prior of record, taken alone or in combination, fails to disclose or render obvious a method for measuring characteristic of a sample comprising the step of moving the sample support or the reflective element upstream and downstream in the optical path, in combination with the rest of the limitations of claim 12.

***Response to Arguments***

Applicant's arguments filed 12/10/03 have been fully considered but they are not persuasive. With regard to claim 1, applicant argues that Examiner is not reading the claim in its entirety. Examiner respectfully disagrees. The claim is written in an

alternative form and thus the claim limitations are met if at least one of the alternatives is taught by the prior art. Furthermore, for the sake of argument, examiner believes that the means for positioning is overcome with manually placing the sample support, reflective element or both within a collection range for detection to occur as explained in the above rejection. With regard to claim 11, examiner respectfully disagrees for the same reasons as state above. Examiner stands on the grounds that optical elements such as lenses and apertures to change to the position of light beams are old and well known in the art (Official Notice has been taken), which in turn would adjust the collection range.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2877

*Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax Machine located in Crystal Plaza 4. The form of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is:*

**703-308-7722**

If the applicant wishes to send a Fax dealing with a Proposed Amendment for discussion for a phone interview then the fax should:

1) Contain either the statement "DRAFT" or "PROPOSED AMENDMENT" on the Fax Cover Sheet; and

2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Examiner Amanda H. Merlino* whose telephone number is (571) 272-2421. The examiner can be reached on Mondays and Thursdays only.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-0956.

Amanda H. Merlino *ahm*  
Patent Examiner  
Art Unit 2877  
March 4, 2003/ahm



**FRANK G. FONT  
SUPERVISORY PATENT  
EXAMINER**